

Remarks:

In the July 31, 2006, Office Action, claims 1-21, 24-26, 31-32, and 34 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Kolling et al. (U.S. Patent No. 5,963,925). Claims 22, 23, 29, and 30 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kolling et al. in view of Hilt et al. (U.S. Patent No. 5,465,206).

35 U.S.C. §102 Rejections

The Office Action rejected claims 1-21, 24-26, 31-32, and 34 under 35 U.S.C. §102(e) as being anticipated by Kolling et al. (U.S. Patent Application No. 5,963,925). This ground of rejection is respectfully traversed. Reconsideration of these rejections in view of the following comments is respectfully solicited.

It is axiomatic in the patent law that to reject a claim under 35 U.S.C. §102, each and every limitation must be found, expressly or inherently, in a single reference and arranged as required by the claims such that the reference discloses the identical invention. *See* MPEP § 2131. Anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference. *See Ex parte Beuther*, 71 USPQ2d 1313 (BdPatApp&Int 2003), citing *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972). However, Kolling '925 does not disclose, explicitly or inherently, the invention claimed by claims 1-21, 24-26, 31-32, and 34 and therefore cannot anticipate these claims because it fails to teach each and every limitation required by these claims as is required by 35 U.S.C. §102 and explained below.

Applicant's invention is a switching system and method for facilitating the electronic presentment and payment of bills between billers and consumers. Applicant's system and method include an open, interoperable (multi-standard) switching network for routing information between billers and consumers, and Applicant's system and method are the only known system and method which can work with billers, consumers, biller service providers, and consumer service providers that are using different message standard protocols such as Open Financial Exchange (OFX) and Interactive Financial Exchange (IFX).

Claims 1 and 9 require, *inter alia*, a switching network which is in electronic communication with a consumer terminal using one of a first message standard protocol and a second message standard protocol with a biller terminal irrespective of which message standard protocol the biller terminal uses. Claims 17 and 25 require, *inter alia*, a switching network

communicating with at least one of a first and second biller terminals and a first and second consumer terminals using a first message standard protocol with at least one of the first and second biller terminals and the first and second consumer terminals using a second message standard protocol.

The references cited in the July 31, 2006, Office Action neither teaches nor suggests Applicant's invention as presently claimed, or, for that matter, this concept.

The Kolling et al. reference only replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery of the bills and nothing more. The Kolling et al. reference simply does not teach Applicant's invention, which uses a switching network to perform both presentment and payment. Further, the Kolling et al. reference does not disclose, teach, or suggest a multi-standard switch which is configured to communicate using a plurality of different message standard protocols. Thus, the Kolling et al. reference does not teach or suggest the multi-standard switching network of the invention as claimed in the amended claims, or, for that matter, the invention claimed in unamended Claim 26.

The Office Action points to column 9, lines 1-24 of Kolling et al. for its support of its statement that the Kolling et al. references teaches the above mentioned claim language of claim 1. Kolling et al at column 9, lines 1-24 states that a CFI delivers an electronic statement using the consumer's medium of choice. Kolling et al. teaches that a suitable medium includes Internet, electronic mail, computer network. etc. It can clearly be seen that a medium of choice is not the same as a messaging protocol (e.g., OFX and IFX). A teaching or suggestion of using a first and second messaging protocol to communicate with different terminals could not be found in Kolling et al.

With respect to claim 21, the Office Action states that column 15, lines 40-55, column 24 line 60 through column 25, line 20, and column 19, line 65 through column 20, line 20 of Kolling et al. teaches the step of verifying that the payment instructions are from consumer terminals which are registered with the switching network, causing the payment instructions to be executed. Column 15, lines 40-55 of Kolling et al. teach that an ESP status field in a universal biller file indicates whether a particular biller is participating in a program. It does not teach or suggest verifying that the payment instructions are from consumer terminals which are registered with the switching network or causing the payment instructions to be executed. Column 24 line 60 through column 25, line 20 of Kolling et al. teach how a consumer service provider is set up for operation in the system of Kolling et al. It does not teach or suggest verifying that the payment instructions are from consumer terminals which are registered with the switching network or causing the payment instructions to be executed. Column 19, line 65 through column 20, line 20 of Kolling et al. teach how a biller is set up for participation in the system of Kolling et al. It does not teach or suggest verifying that the payment instructions are

from consumer terminals which are registered with the switching network or causing the payment instructions to be executed. No teaching or suggestion could be found in Kolling et al. (or Hilt et al.) verifying that the payment instructions are from consumer terminals which are registered with the switching network or causing the payment instructions to be executed.

Claim 26 requires, *inter alia*, a switching network for routing a payment message for a particular bill between the consumer terminal and biller terminal irrespective of whether the particular bill has been previously presented to the consumer terminal. For example, a consumer can make electronic payments that are not linked to a presented bill, thereby allowing the consumer to pay another person without the presentation of a bill through the switching system, even when a debtor/creditor relationship between them does not exist, such as for example, to transfer money to a friend or relative in need of funds, to a child away in school, to make a charitable contribution or to make a purchase on the Internet, etc.

The Office Action refers to column 19, lines 15-20 of Kolling et al. for support for teaching the step of routing a payment message for a particular bill between the consumer terminal and biller terminal irrespective of whether the particular bill has been previously presented to the consumer terminal. Column 19, lines 15-20 of Kolling et al. teaches that electronic statements including invoices are divided into mandatory and optional sections as defined by the biller with mandatory sections being automatically presented to the customer, while optional sections are downloaded and presented only at the consumer request. Clearly receiving an optional section of an electronic statement does not teach or suggest routing a payment message for a particular bill irrespective of whether a particular bill (e.g., a statement with a mandatory with or without an optional section) has been previously presented to the consumer terminal. No teaching or suggestion could be found in Kolling et al. or in Hilt et al., singly or in combination, of a switching network for routing a payment message for a particular bill between said consumer terminal and biller terminal, irrespective of whether the particular bill has been previously presented to said consumer terminal as required by claim 26.

In view of at least the above, it is respectfully submitted that Kolling et al. does not teach or suggest all of the elements of claims 1-21, 24-26, 31-32, and 34. It is therefore respectfully requested that the rejection of claims 1-21, 24-26, 31-32, and 34 be withdrawn and the claims be passed to allowance.

35 U.S.C. §103 Rejections

The Office Action has rejected claims 22, 23, and 33 under 35 U.S.C. §103(a) as being unpatentable over Kolling et al. in view of Hilt et al. (U.S. Patent No. 5,465,206). This ground

of rejection is respectfully traversed. Reconsideration of this rejection in view of the following comments is respectfully solicited.

Claims 22 and 23 depend from claim 21, which depends from claim 17 and are believed to be patentable for the same reasons set forth above with respect to claim 17. Claim 33 depends from claim 1 and is believed to be patentable for the same reasons set forth above with respect to claim 1.

To establish a *prima facie* case of obviousness, a showing of three basic criteria is required. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine teachings. Any proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. See M.P.E.P. 2143. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

The Hilt et al. reference discloses a bill payment system wherein participating consumers may pay bills to participating creditors through a dedicated payment network. The participating consumers receive bills from the participating creditors. To authorize a payment, a participating consumer transmits payment instructions to a participating bank. The participating bank then submits a payment "message" to the subscribed payment network and forwards the payment message to the biller's bank. The Hilt et al. reference thus requires each of the billers and consumers to be associated with the system of Hilt et al. (in order for them to be "participating"), and does not teach or suggest the multi-standard switching network of the present invention. As such, the cited references, alone or in combination, fail to teach or suggest all limitations of the claims. In particular, Hilt et al. fails to make up for the aforementioned deficiencies of Kolling et al. with respect to independent claims 1 and 17. It is therefore respectfully requested that the rejection of claims 22, 23, and 33 be withdrawn.

In conclusion, Applicant believes that the present patent application with Claims 1-26 and 31-34 as amended are patentable at this time. These claims remain pending following entry of this submission, and the patent application with Claims 1-26 and 31-34 is believed to be in condition for allowance at this time. Applicant respectfully requests an early and favorable consideration of the claimed subject matter as amended. Should the Examiner believe that the

prosecution of the patent application can be so expedited, the Examiner is requested to call Applicant's undersigned attorney at the number listed below.

Respectfully submitted:

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